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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,371	03/16/2001	John EN Morten	P277176	9624

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EXAMINER
MYERS, CARLA J

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/787,371	MORTEN, JOHN EN	
	Examiner	Art Unit	
	Carla Myers	1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *6* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *22 January 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☒ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-4,6 and 7*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

CARLA J. MYERS
PRIMARY EXAMINER

Continuation of 2. NOTE: The amendment to the claims to recite SEQ ID NO: 2 in place of EMBL Accession No M92431 and to include SEQ ID NO: 2 in the specification raises new issues under 35 U.S.C. 112 first paragraph (new matter) because while the declaration establishes that an EMBL sequence attached as exhibit A is identical to the EMBL sequence that existed as of September 9, 1998, the declaration does not establish that SEQ ID NO: 2 is identical to the sequence that existed as EMBL Accession No. M92431 as of September 9, 1998.

Continuation of 5. does NOT place the application in condition for allowance because: for the reasons of record in view of the non-entry of the after final amendment. Furthermore, it is noted that the 101 and 112 rejections are not based on the utility of VCAM or the utility of the VCAM promoter. Rather, the rejections are based on the utility of the claimed nucleic acids containing polymorphisms in the VCAM protomoter. Applicants response states that VCAM-1 is constitutively expressed in lymphoid dendritic cells, bone marrow fibroblasts and certain macrophages. However, the specification does not establish that the polymorphisms in the VCAM promoter alter this expression pattern. Applicants state that 5 of the polymorphisms are located in a silencer region of the promoter. However, the specification and response do not establish that the presence of the polymorphisms in the silencer region alters the activity of the promoter/silencer region. Applicants cite post filing date art to show that the polymorphism at position 1467 is within a TEF-1 binding site. However, the specification as originally filed does not indicate that this polymorphism is within the TEF-1 binding site and does not indicate how the presence of this polymorphism alters the activity of the promoter. Applicants further state that upregulation of the VCAM promoter is known to occur in response to inflammation. However, the specification has not established which, if any, of the polymorphisms cause an upregulation of the VCAM promoter and which, if any, of the polymorphisms cause a decrease in promoter activity. It is argued that one of ordinary skill in the art would appreciate the usefulness of one of the disclosed polymorphisms for the purpose of diagnosing inflammatory disease or determining the risk of inflammatory disease. However, for a polymorphism to be used for such a purpose, that polymorphism would have to have the property of increasing expression of VCAM. Again, the specification has only taught the existence of polymorphisms in the VCAM promoter; the specification has not established that any of the individual polymorphisms are associated with increased expression of VCAM .